

**REMARKS**

Applicants thank the Examiner for the thorough consideration given the present application. Claims 1, 2 and 4-19 are now present in the application. Claim 1 is independent

Claim 1 has been amended to incorporate the features of the embodiment of claim 3, which has been canceled. Favorable reconsideration and allowance of the present application is respectfully requested in view of the following remarks.

**Priority Under 35 U.S.C. § 119**

Applicants thank the Examiner for acknowledging Applicants' claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority document.

**Claim Rejections – 35 U.S.C. § 102**

Claims 1, 2, 4, 5 and 9 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Higeta et al. (U.S. Patent 5,162,857). While not conceding the appropriateness of the Examiner's rejection, but merely to advance prosecution of the instant application, Applicants respectfully submit that claim 1 has been amended to incorporate the features of the embodiment of claim 3, which has been canceled, thus rendering this rejection under 35 U.S.C. § 102(b) moot. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

### **Claim Rejections – 35 U.S.C. § 103**

Claims 3, 7, 8, 10, 15-17 and 18 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Higeta in view of Kodama (JP 04208949). Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness and respectfully traverse the rejection.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the cited references must teach or suggest each and every element in the claims. *See M.P.E.P. § 706.02(j); M.P.E.P. § 2141-2144.*

Claim 1 now requires an image forming apparatus that has, among other things, a duplex printing function having a switching means for switching a transport position that differs in the direction perpendicular to the recording medium transport direction when recording an image on the first and second sides, a discharge portion for discharging the recording medium when the image has been printed, wherein the switching means has an offset function provided in the discharge portion that varies the discharge position and wherein the transfer position of the recording medium when recording an image is switched by the offset function of the switching means.

The Examiner relies upon skew roller 102 of Higeta as a switching means. However, skew roller is not in the discharge position. To allegedly show a switching means in a discharge portion, the Examiner turns to Kodama, and refers to ejecting rollers 21 and 22 which are at the discharge portions 11 and 12.

First, with all due respect, it would appear that the Examiner as well as Applicants may be at a disadvantage when it comes to understanding what Kodama does or does not teach because the reference is not in English. Since we do not have the benefit of a full translation, one is left attempting to infer its operation from the Abstract and drawings. If prosecution should proceed further with this reference, it is requested that the Examiner provide a full translation.

So, based upon the Abstract and drawings, it would appear that contrary to what the Examiner alleges, Kodama has ejecting rollers 21 and 22 that are quite remote from and not connected to what appears to be the duplex mechanism 15 in the bottom of the image forming apparatus that retransmits the recording medium for printing on the second side. Therefore, since Kodama does not have the feature that the Examiner relies upon to suggest the feature that the Examiner admits is not present in the base reference, it is submitted that Higeta and Kodama neither show nor suggest that the switching means be provided in the discharge portion. Therefore, it is submitted that amended claim 1 is distinguished from Higeta and Kodama, and that claims 2 and 4-19 which are dependent thereon are also patentable at least for the same reasons as claim 1.

To support the rejections of the remaining claims 6, 11-14 and 19, the Office Action combines Kimoto (U.S. Patent 6,424,365) with the above discussed references. Kimoto shows an image forming apparatus for ensuring printing in the proper positions on both sides of a recording medium. Kimoto does not teach providing a switching means in the discharge portion, and therefore cannot remedy the defects noted above with respect to the combination of Higeta and Kodama.

Accordingly, Applicants respectfully request that the rejections under 35 U.S.C. § 103(a) be withdrawn.

### **Conclusion**

All objections and rejections raised in the Office Action having been properly traversed and addressed, it is respectfully submitted that the present application is in condition for allowance. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Notice of same is earnestly solicited.

Prompt and favorable consideration of this Amendment is respectfully requested.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Charles Gorenstein, Reg. No. 29,271, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.


Application No. 10/550,543  
Amendment dated February 7, 2008  
Reply to Office Action of November 8, 2007

Docket No.: 0951-0171PUS1

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

By 

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